



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/888,462	07/07/97	SCHARF	2730-01

PATENT ADMINISTRATOR  
THE LUBIRZOL CORPORATION  
29400 LAKELAND BOULEVARD  
WICKLIFFE OH 44092-2298

IM11/1214

EXAMINER
MCAYOY, E

ART UNIT	PAPER NUMBER
1721	

DATE MAILED: 12/14/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**Application No.  
**08/888,462**Applicant(s)  
**Scharf et al**Examiner  
**Ellen McAvoy**Group Art Unit  
**1721**☐ Responsive to communication(s) filed on \_\_\_\_\_☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**☒ Claim(s) 1-26 \_\_\_\_\_ is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.☒ Claim(s) 1-26 \_\_\_\_\_ is/are rejected.☐ Claim(s) \_\_\_\_\_ is/are objected to.☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been☐ received.☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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***Continued Prosecution Application***

The request filed on November 30, 1998 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/888,462 is acceptable and a CPA has been established. An action on the CPA follows.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Tipton et al (4,594,378).

Tipton et al ["Tipton"] teach polymeric compositions which exhibit improved shear stability in transmission and hydraulic fluids while maintaining high and low temperature viscosity characteristics. The polymeric compositions comprise a mixture of (A) at least one oil-soluble polymer, (B-1) at least one nitrogen-containing ester of a carboxy-containing interpolymer and/or (B-2) at least one oil-soluble acrylate polymerization product of at least one acrylate ester. The polymeric component (A) may comprise homopolymers prepared from C<sub>3</sub>-C<sub>20</sub> monoolefins such as butene and isobutene. See col. 3, lines 4 et. seq. Number average molecular weights of such polymers range from about 500 to about 100,000. See the claims. The acrylate polymerization

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product, component (B-2), may comprise polyacrylates (when  $X=H$ ) and polymethacrylates (when  $X=CH_3$ ) as set forth in col. 4, lines 25-30. Components (A) and (B-2) of Tipton clearly encompass component (A) of the instant claims which may comprise mixtures of polymer components and Tipton teaches that components (A) and (B-2) combined add to 0.2% to about 30% by weight in either a transmission fluid or a hydraulic fluid which overlaps the range of 15-40% by weight of the instant claims. The polymeric compositions of the prior art may also comprise component (C) at least one low temperature viscosity-reducing liquid organic diluent such as naphthenic oil, alkylated aromatic oils and synthetic carboxylic acid ester oils. See col. 18, lines 13-57. This clearly encompasses fluidizing agent (B) of the instant claims.

The base oils used in preparing the transmission fluids and hydraulic fluids of Tipton may comprise either natural oils or synthetic oils. Mineral lubricating oils are set forth as an example of a preferred natural oil. See col. 23, lines 36 et. seq. Tipton also allows for the addition of conventional lubricant additives to the composition in conventional amounts and include detergent/dispersants, extreme pressure agents, anti-wear agents and oxidation inhibitors. See col. 19, lines 24 to col. 23, top. This clearly encompasses components (C), (D) and (E) of the instant claims. Thus, the Examiner is still of the position that the composition of the instant claims is encompassed by the prior art to Tipton.

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen McAvoy whose telephone number is (703) 308-2510.

The fax numbers for Group 1700 are (703) 305-3599 for Official After Final Fax, (703) 305-5408 for Official Non-Final Fax and (703) 306-3429 for Unofficial Fax.

EMcAvoy  
December 14, 1998

  
ELLEN M. MCAVOY  
PRIMARY EXAMINER  
GROUP 1700